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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/10/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,330

Applicant(s)

ROLLAT ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 167-169, 171, 172, 174, 175, 177, 178, 180-182 and 185-308 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 167-169, 171, 172, 174, 175, 177, 178, 180-182 and 185-308 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 are pending. The Amendment filed 8/6/03, Paper No. 11, cancelled claims 1-166, 170, 173, 176, 179, and 183-134, added claims 185-305, and amended claims 167, 168, 171, 172, 174, 175, 177, 178, 180 and 181.

The indication of Allowable subject matter in the previous Office Action, is hereby withdrawn. See the rejection below for details.

Regarding inventorship, Applicant states, "the Examiner suggested that inventorship was an issue outside of the Examiner's jurisdiction. . .However, the Federal Circuit has stated that Examiners are required to consider inventorship during prosecution of an application. . .Applicants therefore respectfully request confirmation that the Examiner agrees with Applicants' good faith determination of inventorship". The Examiner respectfully points out that the specific matter with which the Applicant desires confirmation is outside of the Examiner's jurisdiction. While the Examiner is able to grant a petition for the correction of inventorship under 37 CFR 1.48 and with proof, is able to question inventorship under 102(f), the Examiner is not able to settle a dispute between L'Oreal and a third party regarding the true inventorship of the instant Application. Regarding 102(f), as pointed out by the Applicant, the Examiner respectfully points out that MPEP 706.02(g) states that "The examiner must presume the applications are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor". In the instant case no evidence has been provided to the Examiner to show that the instant invention was not invented by those

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inventors named in the declaration. The Examiner respectfully directs Applicant to MPEP 2137-2137.02.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12-14, 16-23, 28-41, 44-46, 48-55, 60-70, and 72 of copending Application No. 10/022,253. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant claims and '253 is that the instant claims proviso out certain (meth)acrylic copolymers. However, the instant claims and '253 both teach the same compositions comprising (meth)acrylic copolymers made up of the same monomers.

Claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 13-17, 19-21 of copending Application No. 09/627,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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only difference between the instant claims and '055 is that the instant claims proviso out certain (meth)acrylic copolymers. However, the instant claims and '055 both teach the same compositions comprising (meth)acrylic copolymers made up of the same monomers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 167-169, 180-182, 185-208, 284-307 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (6,013,722).

The instant invention is directed toward a composition comprising a (meth)acrylic copolymer, wherein the copolymer comprises 10-90% of n-butyl acrylate monomers, 2-50% of 2-hydroxy ethyl(meth)acrylate monomers, and up to about 80% of 2-ethyl hexyl acrylate monomers, a surfactant and/or, optionally, a conditioner.

Yang et al. teach a pressure sensitive adhesive emulsion (cosmetically acceptable medium) comprising 50-90% n-butyl acrylate, 10-50% 2-hydroxy ethyl methacrylate, and 2-ethyl hexyl acrylate, and optionally a cross-linking agent. Divinylbenzene multifunctional aziridine amides are taught as the cross-linking agents. Surfactants, plasticizers, dyes, fillers, antioxidants, and UV stabilizers are taught as additional ingredients. Specifically taught as a surfactant is nonylphenoxy or octylphenoxy poly(ethyleneoxy) ethanols, which are nonionic

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polymers. The adhesive has a pH between 1 and 7. The reference lacks preferred percent weights of monomers, polymers in emulsion, and surfactants. See abstract, Col. 2, lines 20-33; Col. 3, line 25-Col. 5, line 55; Col. 13, line 60-Col. 16, line 16.

Since the methacrylate copolymers taught by Yang et al. are the same as those taught by the instant invention, they must have the same Tg.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the percent weight of the monomers and to teach the percent weight of polymers and surfactants, of Yang et al. to reflect the percent weights recited in the instant invention, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

It is respectfully pointed out that the recitation “reshapable hair styling” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is further respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process

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of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the recitation, "said composition provides a reshapable effect and is a shampoo" is a future intended use and is not given patentable weight.

Claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (2002/0058754) in view of Yang et al. (6,013,722).

Engel et al. teach organic particulate filled adhesive comprising particulate dispersed in a polymer matrix containing water-soluble polymer or water-dispersible polymer. The adhesive preferably contains a plasticizer and other additives. Vinyl polymers, such as 2-ethylhexyl acrylate, n-butyl acrylate, hydroxyethylmethacrylate and combinations thereof are taught as comprising the polymer, wherein the polymer comprises 5-40 parts of the matrix. 3-10 parts of anionic, non-ionic surfactants, and mixtures thereof are taught in the emulsion, [0040]. Block copolymers of ethylene oxide and propylene oxide are specifically taught as non-ionic surfactants, wherein these nonionic surfactants are also non-ionic polymers, [0042]. Skin moisturizers are taught as additives that impart a desired property to the adhesive, wherein moisturizers are conditioners. Exemplified are emulsions comprising an oil phase and a water phase (cosmetically acceptable vehicles). The reference lacks an exemplification of the preferred copolymer, crosslinkers, and pH.

Yang et al. teach a pressure sensitive adhesive emulsion (cosmetically acceptable medium) comprising 50-90% n-butyl acrylate, 10-50% 2-hydroxy ethyl methacrylate, and 2-ethyl hexyl acrylate, and optionally a cross-linking agent. Divinylbenzene multifunctional

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aziridine amides are taught as the cross-linking agents. The adhesive has a pH between 1 and 7. The adhesives are taught as water resistance and as imparting low haze to products comprising the adhesives. See abstract, Col. 2, lines 20-33; Col. 3, line 25-Col. 5, line 55; Col. 13, line 60-Col. 16, line 16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the pressure sensitive adhesive polymer comprising 50-90% n-butyl acrylate, 10-50% 2-hydroxy ethyl methacrylate, and 2-ethyl hexyl acrylate, and cross-linking agent taught by Yang et al., for the pressure sensitive adhesive polymer of Engel et al., because of the expectation of achieving a product that is water resistance and imparts low haze, and hence clarity, to the final product.

It is respectfully pointed out that the recitation “reshapable hair styling” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is further respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.



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See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the recitation, "said composition provides a reshapable effect and is a shampoo" is a future intended use and is not given patentable weight.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
September 2, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER 9/8/03